

REMARKS

Claims 38, 40, 54-56, 63, 64, 66, 72, 74, 80-85, 88 and 100-105 are pending in this application. This Amendment will cancel claims 38, 40, 54-56, 74, and 100-102, and will cancel claim 106, which was not previously entered. Applicant expressly reserves the right to pursue protection of any canceled subject matter in a continuing application. This Amendment also will amend claims 63, 80, 81, 83, and 103-105. Claims 80, 81, 83, and 103-105 have been amended to comply with the requirements for dependent claims (*e.g.*, 37 C.F.R. 1.75(c)) in view of the amendment to claim 63.

Support for amended claim 63 is found throughout the specification. In particular, the feature “zinc finger DNA binding domain alone” (emphasis added) in amended claim 63 is supported, at least, at page 10, lines 3-10 (see especially lines 8-10). Support for the feature “zinc finger DNA binding domain peptide interacts directly with a SWI/SNF chromatin remodeling complex” (emphasis added) in amended claim 63 was discussed in the Amendment and Response to Final Office Action, filed October 3, 2006 (the “October 3rd Response”), and has been found by the Office in the Advisory Action to be adequately supported by the specification. Claim 63 also is amended to recite “the nucleic acid regulatory protein zinc finger DNA binding domain” in place of “the zinc finger DNA binding domain . . . of the nucleic acid regulatory protein.” This change is one of form only and is made only to accommodate the readability of the phrase “nucleic acid regulatory protein zinc finger DNA binding domain alone.” The word “peptide” in the phrase “the zinc finger DNA binding domain peptide” has been removed in amended claim 63 in response to the Office’s contention that the word “peptide” encompasses a full-length protein or more than a zinc-finger DNA binding domain alone, which is not Applicant’s intention.

No new matter is introduced by any of the foregoing claim amendments, and no new issues are raised.

Entry of the amendments after final action is appropriate because the amendments are believed to place the claims in a condition for allowance. Moreover, entry of the amendment

would reduce the number of claims, remove the canceled subject matter from consideration and, thereby, simplify issues for appeal.

Upon entry of the foregoing claim amendments, **claims 63, 64, 66, 72, 80-85, 88, and 103-105 will be pending in this application.** Consideration of the claim amendments herein and reconsideration of the 35 U.S.C. §102(a) rejection are requested.

Informal Telephone Conference

Applicant thanks Examiner Marvich for the courtesy of a helpful telephone conference with her representative, Debra Gordon, on November 16, 2006. Examiner Marvich reiterated the Office's position that the claim feature "zinc finger DNA binding domain peptide" means peptides (including a full-length proteins) that "comprise zinc finger [DNA binding] domains" (see, *e.g.*, Advisory Action, "Continuation of 11, page 2; emphasis added). The Office was not persuaded by Applicant's arguments in the October 3rd Response that such a peptide consisted of only the DNA binding domain of a nucleic acid regulatory protein. Accordingly, the §102(b) rejection citing Armstrong *et al*, *Cell*, 95:93-104, 1998 had not been overcome.

Examiner Marvich indicated that Applicant's position with respect to the §102(b) rejection likely would be improved if the claims were amended to make clear that the claimed methods involved only the nucleic acid regulatory protein zinc finger DNA binding domain. Possible claim language and the support for the same in the specification were discussed. One suggestion involved removing the word "peptide" from the phrase "zinc finger DNA binding domain peptide," and reciting that the "zinc finger DNA binding domain alone" (emphasis added) was an element of the claimed method.

Complete agreement on claim amendments or arguments for overcoming the pending §102(b) rejection was not reached; however, the Examiner provided helpful guidance and agreed to consider claim amendments and arguments filed by Applicant in a response to the Advisory Action. It is believed that this Amendment conforms to the spirit of the discussion had during the telephone conference.

Issues Remaining from the Office Action

Obviousness-Type Double Patenting:

Claims 63, 64, 66, 73, 74, and 87 were “provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 9-12 of U.S. Patent Application No. 10/783,672.” In the Advisory Action (“Continuation of 5” on page 2), the Office recognized the abandonment of U.S. Patent Application No. 10/783,672 and, therefore, withdrew this rejection.

Claim Rejections under 35 U.S.C. §112, first paragraph:

Claims 38, 40, 54-56, 63, 64, 66, 72, 74, 80-85, 88 and 100-105 were rejected under 35 U.S.C. §112, first paragraph (written description) on the bases that (i) “the limitation . . . ‘immunoprecipitates with the (a) SWI/SNF chromatin-remodeling complex’” in claims 38 and 63, allegedly, is new matter; and (ii) “the limitation . . . ‘SWI/SNF chromatin remodeling complex consisting of BRG1 and BAF155’” in claim 38, allegedly, were new matter.

The Advisory Action indicates (in “Continuation of 13” on page 2) that “[h]ad the amendment [in the October 3rd Response] been entered, applicants reply would have overcome the rejection of claims 38, 40, 54-56, 63, 64, 66, 72, 74, 80-85, 88 and 100-105 under 35 USC 112, first paragraph for New Matter.” This Amendment incorporates by reference the corresponding arguments made in the October 3rd Response and makes the same claim amendments in response to this rejection; thus, it is respectfully submitted that this rejection will be overcome upon entry of the present Amendment.

Claim Rejection under 35 U.S.C. §102(b):

Claims 38, 40, 54, 63, 64, 66, 72, 74, 80, 83, 84, 87, 88 and 100-105 have been rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Armstrong *et al*, Cell, 95:93-104, 1998 (“Armstrong”). Applicant traverses this rejection, at least, for reasons previously of record and for reasons discussed below.

Upon entry of this Amendment, this rejection will be moot with regard to claims 38, 40, 54, 74, and 100-102, which are canceled herein.

With regard to claims 63, 64, 66, 72, 80, 83, 84, 87, 88 and 103-105, Applicant has amended claim 63 to recite, in relevant part (emphasis added):

“... contacting the chromatin assembled DNA with ... the SWI/SNF chromatin remodeling complex comprising BRG1, and ... the nucleic acid regulatory protein zinc finger DNA binding domain alone”

Support for this claim amendment has been discussed previously.

As discussed with Examiner Marvich by telephone, the word “peptide” has been removed to recite in the claimed method a zinc finger DNA binding domain alone. The zinc-finger DNA binding domain is structurally and functionally well characterized in the art (as discussed in detail in the October 3rd Response). Thus, the structural limits of such a domain should not be questioned (and the Office has not done so). Moreover, to clearly establish that the claimed method involves a zinc-finger DNA binding domain exclusive of other portions of a nucleic acid regulatory protein, the amended claim recites that the chromatin-assembled DNA is contacted with the combination of the “zinc finger DNA binding domain alone” and the “SWI/SNF chromatin remodeling complex comprising BRG1.”

Armstrong does not teach or suggest a method involving “a zinc finger DNA binding domain alone.” Accordingly, Armstrong does not describe (either expressly or inherently) “each and every element as set forth in the claim[s]” (MPEP §2131; emphasis added). Thus, Armstrong can not and does not anticipate the claims under 35 U.S.C. §102(b).

In view of the foregoing claim amendment and arguments, Applicants respectfully request that this rejection be withdrawn.

New Issues Raised by the Advisory Action

The Advisory Action contends (“Continuation of 3” on page 2) that “Applicants’ proposed amendment to claim 74 as well as the addition of claim 106 [in the October 3rd Response] . . . requires new search and consideration of art for example obviousness issues regarding the use of a minimal complex in combination with Armstrong et al.” Applicant

disagrees because this subject matter has been claimed, at least, since the Amendment and Response to Non-Final Office Action, filed May 19, 2006 (see, *e.g.*, claim 74 in that response). The Office was obligated to examine the subject matter at that time.

Nevertheless, to facilitate prosecution of this application, this Amendment will cancel claim 74 and not-entered claim 106. Thus, the contention that a “new search and consideration of art” will be required has been rendered moot and should not be an issue with respect to the claim amendments submitted herein.

CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If it may further issuance of these claims, the Examiner is invited to call the undersigned at the telephone number listed below.

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